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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,897	04/12/2001	Kenichi Ueyama	205733US0	1680

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[REDACTED] EXAMINER

GOLLAMUDI, SHARMILA S

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1616

DATE MAILED: 06/30/2003

(S)

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/832,897	UEYAMA ET AL.
	Examiner Sharmila S. Gollamudi	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 April 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 7-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>17</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt of Request for Continuation, extension of Time, Preliminary Amendment B, Rule 132 Declaration, and Information Disclosure is acknowledged. Claims 1-6 and 7-23 are included in the prosecution of this application.

#### ***Information Disclosure Statement***

The information disclosure statement filed 5/5/03 has been considered, however EP 4215501 since it does not have an English abstract or a translation. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

#### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection based on preliminary amendment B.

#### ***Response to Amendment***

The Rule 132 declaration under 37 CFR 1.132 filed 4/10/03 has been considered but is moot in view of new grounds of rejection.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 7-15, 20-21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruiseco (4,849,214).**

Ruiseco discloses an oil based scalp treatment composition and its application. The composition contains 1g sulfur, 100g castor oil, 200g cod liver oil, 15g peppermint spirit, 50g orange water, 50g spirit of camphor, and 500g of arnica (containing 66% alcohol and 100ml of a drug). See column 2, lines 60-68. A pre-shampoo treatment is disclosed. See column 1, lines 11-13. The composition is applied to the hair followed by placing a cap on the head and a hair dryer is applied for 5 to 10 minutes. The oil composition is then rinsed out by shampooing the hair. See column 3, lines 35-45.

**Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Andersin (824,353).**

Andersin teaches hair oil containing 50% petroleum, 60% rum, 0.1% folliculin, 1% cholesterol, and 1.5% lecithin. The hair oil is rubbed into the hair in a warm state and a cloth is applied to the hair to allow the oil to penetrate into the scalp as long as possible. The composition is then washed and rinsed.

**Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Forestier et al (5,415,854).**

Forestier et al teach a cosmetic composition for protecting the skin. Protective oil containing ethanol 50g and trisiloxane 65 g is taught in example L.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiseco (4,849,214) in view of Strain (4,419,835) or Priest et al (4,296,763).**

As set forth above, Ruiseco discloses an oil based scalp treatment composition and its application. The composition is applied to the hair followed by placing a cap on the head and a hair dryer is applied for 5 to 10 minutes. The reference teaches the use of high heat for the composition to be most effective. The oil composition is then rinsed out by shampooing the hair. See column 3, lines 35-45.

Although Ruiseco discloses heating the hair with a dryer, Ruiseco does not specify the temperature.

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Strain teaches a hair dryer that provides hot air with a temperature range of 85 to 95 degrees Fahrenheit. See column 6, lines 1-5.

Priest et al disclose a hair conditioning composition contained in a heating cap. The composition contains oil and other components. See column 2, lines 3-14. Priest teaches the use of temperatures in the excess of 125 degrees Fahrenheit allow the oil to penetrate the hair. See column 2, lines 15-17.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ruiseco and Strain since Ruiseco does not specify the temperature of the hair dryer. One would be motivated to look to the teachings of Strain since Strain teaches the temperature of the air provided by a hair dry.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings the teachings of Ruiseco and Priest et al and use the instant temperature to treat the hair. One would be motivated to do so since Priest et al teach that a temperature in the excess of 125 degrees Fahrenheit allow the oils to penetrate the hair shaft. Therefore, since Ruiseco teaches the penetration of an oil-based composition into the hair shaft for the treatment of dry skin and scalp, one of ordinary skill would reasonably expect similar results.

**Claims 1-2, 8-21, and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersin (824,353).**

Andersin teaches hair oil containing 50% petroleum, 60% rum, 0.1% folliculin, 1% cholesterol, and 1.5% lecithin. Oils such as olive or castor oil are taught. The hair oil

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is rubbed into the hair in a warm state and a cloth is applied to the hair to allow the oil to penetrate into the scalp as long as possible. The composition is then washed and rinsed. See page 1.

Although Andersin teaches allowing the composition to stay in the hair as long as possible, Andersin does not specify the time.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to vary the amount of time the composition is kept in the hair. One would be motivated to do so since Andersin teaches that it is desirable to allow the hair oil to remain in contact with the scalp as long as possible to allow penetration. Therefore, Andersin clearly teaches a prolonged contact time but also allows for varying the contact time according to the consumer's desire.

In the absence of showing the criticality of using different oil components, it is deemed obvious to one of ordinary skill at the time the invention was made to substitute Andersin's oily components with instant oily components since the instant oily agents are conventionally and routinely utilized in the cosmetic/ hair art. Furthermore, Andersin teaches the use of various oily components (vegetable oils, lipids, and hydrocarbon oils) therefore one of ordinary skill could substitute various conventional oily agents with the expectation of similar results.

**Claims 1-21 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersin (824,353) in view of Priest et al (4,296,763).**

Andersin teaches hair oil containing 50% petroleum, 60% rum, 0.1% folliculin, 1% cholesterol, and 1.5% lecithin. Other oils such as olive oil and castor oil are taught.

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The hair oil is rubbed into the hair in a warm state and a cloth is applied to the hair to allow the oil to penetrate into the scalp as long as possible. The composition is then washed and rinsed.

Although Andersin teaches allowing the composition to stay in the hair as long as possible, Andersin does not specify the time. Further, Andersin does not teach applying heat at the instant temperature.

Priest et al disclose a hair conditioning composition contained in a heating cap. The composition contains oil and other components. See column 2, lines 3-14. Priest teaches the use of temperatures in the excess of 125 degrees Fahrenheit allow the oil to penetrate the hair. See column 2, lines 15-17. Further Priest teaches allowing a contact time of 15-20 minutes. See column 2, line 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings the teachings of Andersin and Priest et al and use the instant temperature and contact time to treat the hair. One would be motivated to do so since Priest et al teach that a temperature in the excess of 125 degrees Fahrenheit allows oils to penetrate the hair shaft. Further, Priest teaches the instant contact time and heat allow for effective conditioning of the hair. Therefore, since Andersin teaches hair oil and its penetration, one of ordinary skill would reasonably expect similar results.

In the absence of showing the criticality of using different oil components, it is deemed obvious to one of ordinary skill at the time the invention was made to substitute Andersin's oily components with instant oily components since the instant oily agents

are conventionally and routinely utilized in the cosmetic/ hair art. Furthermore, Andersin teaches the use of various oily components (vegetable oils, lipids, and hydrocarbon oils) therefore one of ordinary skill could substitute various conventional oily agents with the expectation of similar results.

**Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersin (824,353) in view of Kawada et al (5,916,578).**

Andersin teaches hair oil containing 50% petroleum, 60% rum, 0.1% folliculin, 1% cholesterol, and 1.5% lecithin. Other oils such as olive oil and castor oil are taught. The hair oil is rubbed into the hair in a warm state and a cloth is applied to the hair to allow the oil to penetrate into the scalp as long as possible. The composition is then washed and rinsed.

Although Andersin teaches vegetable oils that inherently contain triglycerides, Andersin does not specify the instant triglycerides. Further Andersin does not teach instant solvents of claim 22.

Kawada et al teach a cosmetic composition for the hair and skin to retain moisture when applied. See abstract. The composition contains lipids and can additionally contain triglycerides. See column 1, lines 19-25. Kawada teaches typical triglycerides are glyceryl tricaprate, glyceryl tricaprilate, and glyceryl-2-ethylhexanoate. See column 11, lines 8-13.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings the teachings of Andersin and Kawada and utilize glyceryl-2-ethylhexanoate and glyceryl tricaprate as the triglyceride source

and the oil agent. One would be motivated to do so since Kawada teaches that these are conventional triglycerides used in the art and Kawada teaches a composition for dry skin. Further, one would expect similar results since Andersin teaches the use of oils that contain triglycerides for hair treatment; therefore it is deemed obvious to substitute a known equivalent for the same purpose.

**Claims 16,18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersin (824,353) in view of Forestier et al (5,415,854).**

Andersin teaches hair oil containing 50% petroleum, 60% rum, 0.1% folliculin, 1% cholesterol, and 1.5% lecithin. Other oils such as olive oil and castor oil are taught. The hair oil is rubbed into the hair in a warm state and a cloth is applied to the hair to allow the oil to penetrate into the scalp as long as possible. The composition is then washed and rinsed.

Andersin does not teach the instant solvent.

Forestier et al teach a cosmetic composition for protecting the skin. Protective oil containing ethanol 50g and trisiloxane 65 g is taught in example L. Forestier teaches the composition in various forms such as oily, alcoholic, or oleoalcoholic lotions. Combining natural or synthetic oils with low base alcohols such as ethanol, glycerin, or propylene glycol makes the latter form. Oils taught are fatty alcohols, esters, and triglycerides etc.

See column 8, lines 15-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Andersin and Forestier et al and substitute Andersin's rum (ethanol) with the instant glycol solvents. One would be

motivated to do so since Forestier teaches the equivalency of ethanol and instant glycols for use in preparing oleoalcoholic lotions. The reference also teaches the equivalency of fatty alcohols, ester oils, and natural oils as oily components in the preparation of the lotion. Further, since Andersin teaches an oleoalcoholic lotion wherein oil and alcohol is mixed, one would be motivated to do so with the expectation of similar results. Thus, it is deemed obvious to substitute a known equivalent for the same purpose.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SSG  
  
June 20, 2003

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER

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